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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,206	01/25/2002	Robert J. Small	M-12178 US	1702

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SAN FRANCISCO, CA 94111

EXAMINER
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MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/057,206

Applicant(s)

SMALL ET AL.

Examiner

Michael A Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 36-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31, 33-35 and 76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's election of claims 1-35 (new claim 76 as well) in Paper No. 7 is acknowledged. Applicants have not traversed this restriction, thus the requirement is still deemed proper and is therefore made FINAL.

**Applicants are reminded to cancel the non elected claims.**

Claims 1 and 4-18 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either (1) Shemo et al. or (2) Fang (227) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 2-3 and 19-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Shemo et al. or (2) Fang (227).

**New claim 76 is rejected under 35 U.S.C. 103(a) as obvious over either (1) Shemo et al. or (2) Fang (227) because this claim defines the features for the intended use of the composition and this is the intended use of the claimed composition provides no patentable weight to a composition claim.**

Claims 1, 4, 5 and 11-18 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brusich et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

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Claims 2-3, 6-10 and 19-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brusic et al. in view of Fang (227).

**New claim 76 is rejected under 35 U.S.C. 103(a) as obvious over Brusic et al. in view of Fang (227) because this claim defines the features for the intended use of the composition and this is the intended use of the claimed composition provides no patentable weight to a composition claim.**

Claims 1, 4, 5 and 11-18 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moeggenborg et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 2-3, 6-12 and 19-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moeggenborg et al. in view of Fang (227) and Dirksen et al.

**New claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moeggenborg et al. in view of Fang (227) and Dirksen et al. because this claim defines the features for the intended use of the composition and this is the intended use of the claimed composition provides no patentable weight to a composition claim.**

Applicant's arguments filed 10/14/03 have been fully considered but they are not persuasive.

Applicants argue that the declaration of Zhefei J. Chen establishes that the instant invention is prior to 12/17/1999 (reduced to practice prior to the reference filing dates). The

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examiner acknowledges the above declaration, but this is insufficient to establish prior invention for the claimed subject matter, for the reasons defined below. As defined in independent claim 1, no amounts are defined for the periodic acid. In independent claim 19, a range of 0.05-0.3 moles/kg is defined for the periodic acid. Finally, dependent claims 3 and 20 define a range of 0.075-0.175 moles/kg for the periodic acid. The declaration, however, only defines one point for the periodic acid, this being 0.1 moles/kg of periodic acid. At most, the declaration establishes prior invention for that specific point. To the contrary of applicants position, the declaration does not show reduction to practice of the entire ranges being claimed. In addition, a 131 declaration can not be used to antedate a reference if the reference claims an invention that is not patentably distinct. As can be seen from Shemo et al., at least, the claims are directed to a composition that comprises an abrasive and periodic acid, thus a 131 declaration can not be used to overcome the reference.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The examiner can be normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Amendments can also be sent by fax to the numbers set forth below:

For after final amendments, the fax number is (703) 872-9311;

For non-final amendments, the fax number is 703 872-9310.


Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Michael Marcheschi

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12/03

**After the move to the new USPTO headquarters in Alexandria, Virginia tentatively scheduled for the week of 12/22/03 the examiner's new phone number will be (571) 272-1374 and Mr. Bell's new phone number will be (571) 272-1362.**



MICHAEL MARCHESCHI  
PRIMARY EXAMINER